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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/339,698 06/24/99 RICH

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MM91/0803

EXAMINER

COLILLA, D

ART UNIT

PAPER NUMBER

2854

DATE MAILED:

08/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/339,698

Applicant(s)

RICH ET AL.

Examiner

Dan Colilla

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2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-23 is/are allowed.
- 6) ☒ Claim(s) 16 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 1999 is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 5/19/00 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 5/19/00 have been approved.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the printing of game pieces on a web (as recited in all the claims) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 16 and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldman et al.

With respect to claim 16, Goldman et al. discloses the method of printing a grid of game pieces on a web as shown in Figures 4-5 of Goldman et al. show a grid of game pieces in web form. This web is printed on by a high speed printer as disclosed in col. 16, lines 18-23. A repetitive printing process is used to print the first type of indicia 26 which is a lot number as disclosed in col. 6, lines 47-53 of Goldman et al. And a variable printing process of a second

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type of indicia 28 which is in registry with the first type of indicia 26 is also printed. Second indicia 28 is a unique number for each game piece as disclosed in col. 6, lines 54-65. These game pieces are further printed over with a foil leaf to conceal the game data and inhibit prediction of the game outcome as described in col. 16, lines 47-53.

With respect to claim 24, the above rejection also applies, only in this case, the categorical information is the first type of indicia 26 as disclosed by Goldman et al. and the conditional information is the second type of indicia 28 as disclosed by Goldman et al.

With respect to claims 25-27, since the conditional game information 28 is a changing number unique to each game ticket, this number would change depending on where the ticket is in the web 50, widthwise or lengthwise (see col. 6, lines 54-65 of Goldman et al.).

With respect to claim 28, the conditional information 28 changes as the categorical information 26 remains the same.

*Allowable Subject Matter*

5. Claims 17-23 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

Claims 17-23 have been indicated as containing allowable subject matter because the entire method of printing a grid of promotional game pieces on a web including printing categorical information and conditional information such that the resolution of the repetitive printing process is higher than that of the resolution of the categorical information could not be found in the prior art of record.

*Response to Arguments*

7. Applicant's arguments filed 5/19/00 have been fully considered but they are not persuasive of any error in the above rejection.

The above new grounds of rejection using the Goldman et al. reference appears appropriate since Goldman et al. discloses printing both repetitive and variable information on a web of game tickets. The introduction of these new grounds of rejection are required by applicants amendment regarding printing all the information while the game tickets are in web form and the inclusion of new claims 24-28.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten can be reached on (703) 308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Dan Colilla  
Examiner  
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August 2, 2000